



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,330	04/01/2004	Mark Stickland	065424-9095	8760

23409 7590 09/15/2005

MICHAEL BEST & FRIEDRICH, LLP
100 E WISCONSIN AVENUE
MILWAUKEE, WI 53202

EXAMINER

HOPKINS, ROBERT A

ART UNIT	PAPER NUMBER
----------	--------------

1724

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/816,330	Applicant(s) STICKLAND ET AL.	
	Examiner Robert A. Hopkins	Art Unit 1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 12, 13, 19, 23-25, 34 and 40 is/are rejected.
- 7) ☒ Claim(s) 4-11, 14-18, 20-22, 26-33, 35-39, 41 and 42 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

ku

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3,12,13,19 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Virgilio(6736884).

Virgilio teaches a separator tank assembly comprising a cast hollow tank(5) having a closed end and an open end with a separator chamber therebetween, a cast lid(19) substantially closing the tank open end, and a first integral fluid passage(23) formed in the cast hollow tank and cast lid and extending from the separator chamber to at least one external port. Virgilio further teaches wherein the first integral fluid passage is a compressed air passage and wherein at least a first integral port is formed along the first integral fluid passage between the separator chamber and the external port. Virgilio further teaches wherein the first integral port is configured to receive a separator element(15). Virgilio further teaches wherein the external port is configured for providing compressed air to an external environment. Virgilio further teaches wherein the first integral fluid passage is a lubricant passage and wherein at least a first integral port is formed along the first integral fluid passage between the separator chamber and the

Art Unit: 1724

external port. Virgilio further teaches wherein the first integral port is configured to receive a lubricant filter(15).

Claims 23-25,34,40 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Virgilio(6736884).

Virgilio teaches a separator tank assembly comprising a cast hollow tank(5) having a closed end and an open end with a separator chamber therebetween, a cast lid(19) substantially closing the tank open end, and a first integral fluid passage(23) formed in the cast hollow tank and cast lid and extending from the separator chamber to at least one external port configured for providing compressed air to an external component, and a second integral fluid passage(9) formed in the cast hollow tank and cast lid and extending from the separator chamber to a second external port configured for returning cleaned lubricant to an associated compressor assembly. Virgilio further teaches a first integral port is formed along the first integral fluid passage between the separator chamber and the first external port. Virgilio further teaches wherein the first integral port is configured to receive a separator element(15). Virgilio further teaches wherein a third integral port is formed along the second integral fluid passage between the separator chamber and the second external port. Virgilio further teaches wherein the third integral port is configured to receive a lubricant filter(16).

Allowable Subject Matter

Claims 4-11,14-18, 20-22,26-33,35-39,41,42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 4,20,26 recite "wherein the first integral port has a first integral separator passage extending from the first integral fluid passage to the separator element and a second integral separator passage extending from the separator element to the first integral fluid passage". Virgilio fails to teach wherein the first integral port has a first integral separator passage extending from the first integral fluid passage to the separator element and a second integral separator passage extending from the separator element to the first integral fluid passage. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the first integral port has a first integral separator passage extending from the first integral fluid passage to the separator element and a second integral separator passage extending from the separator element to the first integral fluid passage because Virgilio does not suggest such a modification. Claims 5 and 6 depend on claim 4 and hence would also be allowable upon incorporation of claims 2-4 into claim 1. Claim 21 depends on claim 20 and hence would also be allowable upon incorporation of claims 20,19, and 13 into claim 1. Claims 27 and 28 depend on claim 26 and hence would also be allowable upon incorporation of claims 24-26 into claim 23.

Claims 7 and 29 recite "wherein the cast tank has a separator element mounting surface formed integral therewith about the first integral port". Virgilio teaches a cover having a separator element mounting surface". It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the cast tank has a separator element mounting surface formed integral therewith about the first integral port passage because Virgilio does not suggest such a modification.

Art Unit: 1724

Claims 8-10 depend on claim 7 and hence would also be allowable upon incorporation of claims 7,3, and 2 into claim 1.

Claim 11 recites "wherein the external port is configured to receive a minimum pressure check valve...". Virgilio teaches an external port connected to a radiator. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the external port is configured to receive a minimum pressure check valve because Virgilio does not suggest such a modification.

Claims 14 and 35 recites "wherein the first integral port is configured to receive a thermal valve assembly". Virgilio fails to teach wherein the first integral port is configured to receive a thermal valve assembly. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the first integral port is configured to receive a thermal valve assembly because Virgilio does not suggest such a modification. Claims 15-18 depend on claim 14 and hence would also be allowable upon incorporation of claims 14 and 13 into claim 1.

Claim 30 recites" further comprising a second integral port formed along the first integral fluid passage between the first integral port and the first external port". Virgilio fails to teach a second integral port formed along the first integral fluid passage between the first integral port and the first external port. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide a second integral port formed along the first integral fluid passage between the first integral port and the first external port because Virgilio does not suggest such a modification.

Art Unit: 1724

Claims 31 and 32 depend on claim 30 and hence would also be allowable upon incorporation of claims 30, 25, and 24 into claim 23.

Claim 33 recites "wherein the first integral port is configured to receive a minimum pressure check valve". Virgilio fails to teach wherein the first integral port is configured to receive a minimum pressure check valve. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the first integral port is configured to receive a minimum pressure check valve because Virgilio does not suggest such a modification.

Claims 35 recites "wherein the third integral port is configured to receive a thermal valve assembly". Virgilio fails to teach wherein the third integral port is configured to receive a thermal valve assembly. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein the third integral port is configured to receive a thermal valve assembly because Virgilio does not suggest such a modification. Claims 36-39 depend on claim 35 and hence would also be allowable upon incorporation of claims 35 and 34 into claim 23.

Claim 41 recites "wherein the third integral port has a first integral filter passage extending from the second integral fluid passage to the lubricant filter and a second integral filter passage extending from the lubricant filter to the second integral fluid passage...". Virgilio fails to teach wherein the third integral port has a first integral filter passage extending from the second integral fluid passage to the lubricant filter and a second integral filter passage extending from the lubricant filter to the second integral fluid passage. It would not have been obvious to someone of ordinary skill in the art at

Art Unit: 1724

the time of the invention to provide wherein the third integral port has a first integral filter passage extending from the second integral fluid passage to the lubricant filter and a second integral filter passage extending from the lubricant filter to the second integral fluid passage because Virgilio does not suggest such a modification.

Claim 42 recites "wherein a third integral fluid passage extends between the separator chamber and a fifth integral port configured to receive a sight glass". Virgilio fails to teach wherein a third integral fluid passage extends between the separator chamber and a fifth integral port configured to receive a sight glass. It would not have been obvious to someone of ordinary skill in the art at the time of the invention to provide wherein a third integral fluid passage extends between the separator chamber and a fifth integral port configured to receive a sight glass because Virgilio does not suggest such a modification.

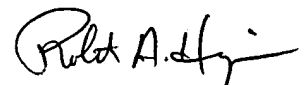
Art Unit: 1724

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert A. Hopkins whose telephone number is 571-272-1159. The examiner can normally be reached on Monday-Friday, 7am-4pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Rah
September 13, 2005


ROBERT A. HOPKINS
PRIMARY EXAMINER

A.U. 1724